

United States Patent and Trademark Office



UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER OF PATENTS AND TRADEMARKS Washington, D.C. 20231 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
09/824,590	04/03/2001	Takahiro Imada	K-1970	8697	
75	90 06/12/2002				
KANESAKA & TAKEUCHI			ЕХАМГ	EXAMINER	
1423 POWHAT ALEXANDRIA			MARX, I	IRENE	
			ART UNIT	PAPER NUMBER	
			1651 DATE MAILED: 06/12/2002	5	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/824,590

Applicant(s)

Examiner

lmada et al.

Irene Marx

Art Unit 1651



	The MAILING DATE of this communication appears	on the cover s	heet with	the correspondence address		
	for Reply					
THE N	ORTENED STATUTORY PERIOD FOR REPLY IS SET MAILING DATE OF THIS COMMUNICATION.					
mailing	ions of time may be available under the provisions of 37 CFR 1.136 (a). In r					
- If the p - If NO p - Failure - Any re	period for reply specified above is less than thirty (30) days, a reply within the period for reply is specified above, the maximum statutory period will apply at to reply within the set or extended period for reply will, by statute, cause the ply received by the Office later than three months after the mailing date of the patent term adjustment. See 37 CFR 1.704(b).	nd will expire SIX (6 e application to bec	3) MONTHS f ome ABAND(rom the mailing date of this communication. DNED (35 U.S.C. § 133).		
Status						
1) 🗆	Responsive to communication(s) filed on			•		
2a) 🗌	This action is FINAL . 2b) 💢 This acti	ion is non-fina	al.			
3) 🗆	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.					
Disposi	tion of Claims					
4) 💢	Claim(s) <u>1-14</u>			is/are pending in the application.		
4	a) Of the above, claim(s)			is/are withdrawn from consideration.		
5) 🗆	Claim(s)			is/are allowed.		
6) 🗆	Claim(s)			is/are rejected.		
7) 🗆	Claim(s)	والمراجع والم والمراجع والمراجع والمراجع والمراجع والمراجع والمراجع والمراج		is/are objected to.		
8) 💢	Claims 1-14	ar	e subject	to restriction and/or election requirement.		
Applica	ition Papers					
9) 🗌	The specification is objected to by the Examiner.					
10)	The drawing(s) filed on is/are	a) accept	ed or b)	objected to by the Examiner.		
	Applicant may not request that any objection to the de	rawing(s) be h	eld in abe	yance. See 37 CFR 1.85(a).		
11)	The proposed drawing correction filed on	is	s: a) □ a	approved b) \square disapproved by the Examiner.		
	If approved, corrected drawings are required in reply t					
12)	The oath or declaration is objected to by the Exami	ner.				
Priority under 35 U.S.C. §§ 119 and 120						
13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).						
a)[☐ All b)☐ Some* c)☐ None of:					
	$label{eq:lambda} ar{l}$. \square Certified copies of the priority documents have	e been receiv	ed.			
	2. Certified copies of the priority documents have	e been receiv	ed in App	olication No		
	3. Copies of the certified copies of the priority do application from the International Burea	au (PCT Rule	17.2(a)}.			
	tee the attached detailed Office action for a list of the					
_	Acknowledgement is made of a claim for domestic					
_	The translation of the foreign language provisiona					
15)∟	Acknowledgement is made of a claim for domestic	priority under	7 35 U.S.	C. 33 120 and/or 121.		
Attachm	nent(s) · otice of References Cited (PTO-892)	4) Intension S	Summer /DT/	O-413) Paper No(s)		
	otice of prefrences Cited (P10-892) otice of Draftsperson's Patent Drawing Review (PT0-948)	_	•	t Application (PTO-152)		
_	3) Information Disclosure Statement(s) (PTO-1449) Paper No(s)					

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-6 drawn to a symbiotic fungus, classified in Class 435, subclass 254.1, for example.
 - II. Claims 7-12 drawn to a plant, classified in Class 800, subclass 295, for example.
- III. Claims 13-14 drawn to process of infecting plants with fungi, classified in Class 424, subclass 93.5, for example.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as for a process for obtaining antibodies or as host cells in processes involving the use of recombinant DNA or for the production of single cell protein for nutritional supplementation, none of which processes require the infection of a plant.

Each of groups I and II is directed to separate and distinct inventions, Group I is directed to symbiotic fungus and group II is directed to a plant containing a fungus. The products of groups I and II would be expected to have distinct morphological, functional and physiological properties as evidenced by divergent classification, process of making and process of using. These products are not required one for the other.

The several inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches (as indicated by the different classification). The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of Group I would not necessarily anticipate or make obvious the any of the other groups.

For these reasons restriction for examination purposes is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Serial No. 09/824590 Art Unit 1651

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irene Marx whose telephone number is (703) 308-2922. The examiner can normally be reached on Monday through Friday from 6:30 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The appropriate fax phone number for the organization where this application or proceeding is assigned is before final (703) 872-9306 and after final, (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service whose telephone number is (703) 308-0198 or the receptionist whose telephone number is (703) 308-1235.

Irene Marx Primary Examiner

Art Unit 1651